

REMARKS

Claims 1-23 are pending in the current Application. No Amendments to the claims are being made herein.

Applicants respectfully submit that claims 1-8, 10-12, 15, and 21-23 are patentable under 35 U.S.C. 102(e) over Phelps et al. (US Pub 2004/0221111). Phelps et al. was filed April 30, 2003, and published Nov. 4, 2004. Applicants have previously submitted Declarations under 37 C.F.R. 1.131 from each inventor of the current Application to show that conception occurred prior to April 30, 2003, and that the current Application was then diligently constructively reduced to practice on July 31, 2005 (the filing date of the current Application).

The Examiner, in the Response to Arguments mailed in the Final Rejection, stated that the “affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to a particular date. Vague and general statements in broad terms about what the exhibits describe alone with a general assertion that the exhibits describes a reduction to practice does not satisfy the requirements of 37 CFR 131(b).” Applicants respectfully disagree with the Examiner’s statements and respectfully submit that the Examiner has misunderstood the declarations. Firstly, Applicants were not relying on the exhibits of the declaration to show completion of the invention prior to a date. Nor did the declarations make a general assertion that the exhibits describe a reduction to practice. For example, Exhibit B (a printout of an excerpt from a document describing the Prefetch Control and Platform Flash BIU Configuration Register) was provided to show *conception* of the invention. The declaration clearly points to the Prefetch Control and Platform Flash BIU Configuration Register of Exhibit B which, for example, includes a PFBIU Prefetch Limit Field which “controls the prefetch algorithm used by the PFBIU prefetch controller” and “defines a limit on the maximum number of sequential prefetches which will be attempted between buffer misses.” This, in combination with the rest of the excerpt in Exhibit B, clearly shows conception of the invention as claimed. Applicants are then relying on the filing of the current Application itself for reduction to practice (i.e. a *constructive* reduction to practice). The filed Application clearly provides sufficient evidence of constructive reduction to practice. Therefore, the Declaration and accompanying Exhibits are used to show conception prior to a particular date, as well as provide evidence of subsequent diligent constructive reduction to practice (note that the facts detailing the diligent constructive reduction to practice were clearly described in the previous response filed September 2, 2005, and therefore will not be repeated herein). Therefore, for at least these reasons, Applicants submit that the declarations submitted

clearly provide the facts or data relied upon to show conception and subsequent constructive reduction to practice, and that the declarations did not simply include vague and general statements in broad terms.

In summary, since the declarations and accompanying exhibits clearly describe conception prior to April 30, 2003 (with, e.g., the submission on April 25, 2003, into the Freescale innovation disclosure system) and clearly provide statements and evidence that the innovation was subsequently diligently constructively reduced to practice, Applicants submit that these declarations are sufficient to remove Phelps et al. as a 102(e) reference. For at least these reasons, Applicants submit that claims 1-8, 10-12, 15, and 21-23 are patentable over Phelps et al.

Claims 9, 13, 14, and 16-20 are rejected under 103(a) as being unpatentable over Phelps et al. in view of Bearden. However, since these claims depend directly or indirectly from allowable independent claims 1, 10, and 15, Applicants submit that these claims are also allowable.

Conclusion

Although Applicants may disagree with statements made by the Examiner in reference to the claims and the cited references, Applicants are not discussing all these statements in the current Office Action, yet reserve the right to address them at a later time if necessary.

Applicants respectfully solicit allowance of the pending claims. Contact me if there are any issues regarding this communication or the current Application.

If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 503079, Freescale Semiconductor, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Freescale Semiconductor, Inc.
Law Department

Customer Number: 23125

By: _____



Joanna G. Chiu

Attorney of Record

Reg. No.: 43,629

Telephone: (512) 996-6839

Fax No.: (512) 996-6854